RESPONSE TO OFFICE ACTION MAILED JUNE 6, 2006
Application No. 10/707,819

This communication is in response to the Notice of Non-Compliant Amendment mailed on June 6, 2006 by US Patent Office, Application No. 10/707,819.

US Patent Office determined that my previous Response filed on May 18, 2006 is not compliant, since claims 41 and 42 have not been identified.

I respectfully submit the corrected version of my RESPONSE.

With respect,

Dmitry Noraev, Ph.D.

RESPONSE TO OFFICE ACTION MAILED FEBRUARY 27, 2006
APPLICATION NO. 10/707,819

(RE-FORMATTED VERSION)

I have carefully considered the Office Action mailed on February 27, 2006 and submit the following response: I elect Group 3 (Class 705, subclass 51) with traverse.

Under MPEP 806.05 (h), *a product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown:*

(A) *the process of using as claimed can be practices with another materially different product.* In the instant case, the process claimed in 28-38 can not be used with another materially different product. For example, the step of **conducting an alteration test** of the medium can not be verifiably performed unless the medium enabled for controlled and verifiable alteration (claimed in 1-11, 39) is used.

(B) *the product as claimed can be used in a materially different process.* The Patent Office erred in determining that the product (the medium claimed in 1-11, 39) can be used with a process, other than the one claimed in 28-38. In fact, the essence of the invention is that unless the method claimed in 28-38 is followed, the end user will **not** be able to use the medium claimed in 1-11, 39. For example, the conventional reading of the medium can not be performed by a designated data rendering system unless the alteration of the medium takes place (please refer to Fig 8 for top-level logic governing the designated data rendering system). Claim 1 has been amended for further clarity on this point.

The Patent Office erred in applying MPEP 806.05 (g). MPEP 806.05 (g) governs *an apparatus and a product* **made by** *the apparatus*. The medium claimed in 1-11, 39 is **not a product made by** the designated data rendering system claimed in 12-27, 40-42.

Claims 1-11, 39 are drawn to a data storage medium comprising means for subsequent alteration by an external influence in a manner detectable by a designated data rendering system. Only the designated data rendering system (claimed in 12-27, 40-42) comprising an **alteration detector** for determining an alteration status of the medium can detect the controlled alteration of the medium claimed in 1-11, 39. Thereby, Claims 1-11, 39 and Claims 12-27, 40-42 can not be regarded as "*two or more independent and distinct inventions*" under 35 U.S.C. § 121.

The data storage medium claimed in 1-11, 39 comprises means for **controlled and verifiable** alteration. Any data storage medium can be altered (for example, scratched). The novel medium claimed herein can be altered in a way **detectable** only by a designated data rendering system (claimed in 12-27, 40-42) having an **alteration detector**.

Under MPEP 806.05 (e), *a process and apparatus for its practice can be shown to be distinct inventions, if either*

(A) the process as claimed can be practiced by another materially different apparatus or by hand. In the instant case, the method claimed in 28-38 can **not** be practiced by another

materially different apparatus. Specifically, the step of delivering said medium to end user's data rendering system, said system **restricting access** to at least part of the content **prior to** said **medium alteration**; and the step of **conducting an alteration test** of the medium can not be practiced unless the apparatus claimed in 12-27, 40-42 is used.

(B) The apparatus as claimed can be used to practice another and materially different process. As mentioned in the paragraph 0037 of the present application, for the claimed apparatus to be commercially viable, it **must** be backward-compatible. The back-compatibility is also the subject of Claim 14 of the present application. The system claimed in 12-27, 40-42 can indeed be used to read a conventional CD while **not enforcing the content usage agreement**. However, the claimed apparatus can **not** be used to practice another and materially different process to accomplish the **same purpose**, i.e. to **enforce** restrictive covenants of **the content usage agreement**. The claimed apparatus can only be used to practice another and materially different process to accomplish the **purpose different** from the one stated in the application. Under Patent Office's current interpretation of the guideline (not taking into account the purpose of usage), no electric device could be patented along with the process, since every electric device can be used as a small, portable heater, i.e. can be used to practice another materially different process.

The restriction imposed on the present application **is not consistent** with the prior practice by the Patent Office in the field of the invention:

1. A **method**, an **apparatus**, and a computer readable **storage medium** for selling digital content are claimed in a single US patent 6,978,256 by Hitachi, Ltd.
2. A secure digital image projection **system**, a secure digital data media player (**apparatus**), and a secure data storage **medium** are claimed in a single US patent 7,006,995 by Texas Instrument Inc.
3. A computer implemented **method** of selling digital contents, an **apparatus** for selling digital contents, a **medium** for recording a program, a computer readable storage **medium** are claimed in a single US patent 6,928,423 by Hitachi, Ltd.
4. A data processing **apparatus**, a data processing **method**, a data reading **apparatus**, and a data recording **apparatus** are claimed in a single US patent 7,013,078 by Sony Inc.
5. A reproduction **apparatus** and a reproduction **method** of digital video signal or audio signal are claimed in a single US patent 6,996,545 by Hitachi, Ltd.
6. A license devolution **apparatus** and a license devolution **method** are claimed in a single US patent 6,999,947 by Fujitsu, Ltd.
7. A copyright management **apparatus**, a **system** for distributing copyrighted works, a **method** for distributing copyrighted works, a **method** for managing copyrights for copyrighted works in a system, and a copyright management **system** are claimed in a single US patent 6,928,423 by Sony Inc.
8. A **method** and an **apparatus** of restricting a copy of digital information in a single US patent 6,990,584 by Pioneer Inc.
9. A **method** to deliver encrypted digital content and a computer readable **medium** containing programming instructions for delivery of encrypted digital are claimed in a single US patent 6,983,371 by IBM Inc.

10. A **method** of authentication, a contents-information sender **apparatus**, and a contents-information receiver **apparatus** are claimed in a single US patent 6,983,369 Victor Co. of Japan.

The prosecution of the above patents was not deemed to be *a serious burden on the examiner* under MPEP 808. Similarly, the prosecution of the present application does not impose *a serious burden on the examiner* under MPEP 808.

Since all of the asserted grounds for the restriction are successfully traversed, it is respectfully requested that the restriction for examination is removed.

With respect,

Dmitry Noraev, Ph.D.